

**Amendments to the Drawings:**

The attached fourteen (14) sheets of drawings depicting Figures 1-15 are replacement drawing for the originally filed fourteen (14) sheets of informal drawings depicting Figures 1-15. The attached sheets should replace the originally filed drawings. Care has been taken to see that no new matter has been submitted.

Attachments: Fourteen (14) replacement drawing sheets (Figures 1-15).

### Remarks

This Amendment is in response to the non-final Office Action mailed November 3, 2005. Claims 1, 2, 4-9, 11-16, 19-44 and 46-55 were pending in this application prior to the Office Action of November 3, 2005. These claims had been subjected to a restriction requirement, and the Examiner has withdrawn from consideration Claims 8, 9, 11-16, 19-44 and 46-50.

Claims 8, 9, 11-14, 40-44 and 46-50 have herein been canceled. Withdrawn Claims 16, 24 and 29-36 have herein been amended to now depend directly or indirectly on Claim 1, and as such, should now be examined along with Claim 1. New Claims 56-71 have herein been added and contain claim limitations relating to the structure and function of the flats mail autotraying system claimed in Claims 1, 2, 4-7 and 51-55, and as such should also be examined along with Claims 1, 2, 4-7 and 51-55. Care has been taken to see that no new matter has been added. The same number of claims canceled have been added, and as such, no additional claims fee is due.

In response to the last restriction requirement, Applicants' argued, *inter alia*, that the restriction between Claims 1-7 and Claims 15-39 was improper because the Examiner failed to make a *prima facie* case of restriction between these two groups. The Examiner has stated that Applicants' transversal was on the ground(s) that invention I and II are not related as combination and subcombination. This is incorrect. Applicants argued that restriction was improper because, as best understood, Claim 15 was the combination claim, Claim 1 was the subcombination claim, and that combination Claim 15 did in fact require the particulars of the subcombination Claim 1.

In maintaining the restriction requirement, the Examiner apparently is still considering Claim 1 to be the combination and Claim 15 to be the subcombination. By definition, the Examiner's finding is erroneous. As indicated in MPEP 806.05(a), a combination is an

organization of which a subcombination or element is a part. Claim 15 is a combination AB<sub>SP</sub> (stack accumulator including means for combining small stacks into large stack in sequence order and means for transferring to tray (B<sub>SP</sub>), and an output tray station (A)) of which the elements of Claim 1 (stack accumulator including means for combining small stacks into large stack in sequence order and means for transferring to tray (B<sub>SP</sub>)) is a part.

Pursuant to MPEP §806.05(c)(II), where the relationship between the claims is such that separately claimed subcombination B<sub>SP</sub> (stack accumulator with means for combining small stacks into large stack in sequence order and means for transferring to tray, Claim 1) constitutes essential features of the combination AB<sub>SP</sub> ("A" being the output tray station, Claim 15) as claimed, the inventions are examinable together. A requirement for restriction between elected subcombination Claim 1 and combination Claim 15 is not proper, even though the subcombination may have separate utility.

Applicants respectfully submit that the Examiner has again failed to make a *prima facie* case of restriction between these two groups. It is respectfully requested that the restriction requirement be withdrawn, and that all of the claims as set forth herein, be further examined together. To the extent that the Examiner maintains the restriction requirement between Claims 1-7 and 15-39, Applicants respectfully request that the Examiner specifically explain how Claim 1 could be considered a combination, and Claim 15 a subcombination, identifying the elements of the combination and the elements of the subcombination, so that Applicant's will be better able to understand the Examiner's restriction requirement and make an appropriate response via appeal or petition.

New corrected drawings have been required. Accordingly, attached hereto are replacement drawing sheets providing the required new corrected drawings.

Claims 1, 2, 4, 5, 51 and 53 have been rejected under 35 U.S.C. §102(b) as being anticipated by Lazzarotti (US 5,803,704). For the following reasons, the Examiner's rejection is respectfully traversed.

Lazzarotti is not the same ("identity of invention") as Claims 1, 2, 4, 5, 51 and 53, and thus does not anticipate the same under the law pertaining to 35 U.S.C. §102:

[A]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, **arranged as in the claim**. ... The issue is decided by identifying the elements of the claims, **determining their meaning in light of the specification** and prosecution history, and identifying corresponding elements disclosed in the allegedly anticipating reference....

An anticipatory reference must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the claimed invention without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the reference. ... [A]n **anticipation must speak affirmatively and with certainty; must disclose the invention without debate**; ... (emphasis added, citations omitted) Idacon Inc. v. Central Forest Products Inc., 3 USPQ2d 1079, 1089 (ED Ok 1986). Accord: Glaverbel S.A. v. Northlake Marketing & Supply Inc., 33 USPQ2d 1496, 1498 (CAFC 1995).

The elements of Claims 1, 2, 4, 5, 51 and 53, as determined or interpreted in light of the specification and drawings, are not anticipated by the cited prior art. Applicants respectfully assert that the Examiner's anticipation rejection fails to meet the above identified requirements of the law pertaining to 35 U.S.C. §102.

As a general overview, Applicant's flats mail autotraying system comprises a stack accumulator which combines multiple small stacks of mailpieces into a single large stack of mailpieces in a desired sequence. This process continues until the single large stack obtains a certain height, at which time the large stack is transferred by the stack accumulator into a mail tray. Lazzarotti does not combine multiple small stacks of mailpieces into a single large stack of mailpieces. Instead, Lazzarotti merely stacks individual mailpieces singularly into a stack (see

e.g., Column 2, lines 57-60, and Figures 1,2 and 5), and further differs significantly in both structure and function from Applicants' flats mail autotraying system.

Accordingly, under the law pertaining to 35 U.S.C. §102, Lazzarotti clearly fails to anticipate numerous elements in Claims 1, 2, 4, 5, 51 and 53, including the following:

- the stack accumulator having means for combining multiple small stacks of mailpieces into a single large stack of mailpieces while maintaining sequence order, and also having means for transferring the large stack of mailpieces to a tray, as in Claim 1 (there is no single large stack of mailpieces created from combining multiple small stacks in Lazzarotti, and sequence order would not be maintained even if attempted).

- the means for releasably engaging a tray, as in Claim 2 (the tray lifter 62 of Lazzarotti is separate from the bin 12, which simply drops the stack into the bin without any engagement of the tray, i.e., there is no corresponding structure in Lazzarotti which releasably engages the tray).

- the means for combining multiple small stacks includes a fork lift assembly, as in Claim 4 (Lazzarotti does not disclose any means for combining multiple small stacks, nor does it disclose a fork lift assembly. Element 58 of Lazzarotti is an air cylinder or driver which pushes the bin 12 laterally, and has nothing to do with lifting the stack or combining stacks (see Column 5, lines 35-40).

- the fork lift assembly is moved into and out of contact with a large stack of mailpieces, as in Claim 5 (Lazzarotti fails to move a forklift assembly into and out of engagement with a single large stack of mailpieces).

- the stack accumulator having at least one of a side guide assembly and a rear guide assembly, as in Claim 51 (Lazzarotti has no such corresponding structure. Element 30 of

Lazzarotti is not a side guide assembly. Element 30 of Lazzarotti is a plurality of fingers which help push the stack off of plate 16 (see Column 6, lines 8-13)).

- a sensor for initiating a fork lift cycle when one of the small stacks is sensed by the sensor, as in Claim 53 (Lazzarotti does not anticipate sensing small stacks. There are no small stacks in Lazzarotti to sense. Lazzarotti does not anticipate a fork lift cycle. There is no fork lift assembly in Lazzarotti to cycle. Sensor 54 in Lazzarotti is used to sense the height of the stack to adjust and maintain a preferred upper position for the top of the stack (see Column 5, lines 5-13). This sensor is used for an entirely different purpose than Applicants' claimed sensor).

For the above reasons, Lazzarotti clearly fails to anticipate numerous elements in Claims 1, 2, 4, 5, 51 and 53, under the law pertaining to 35 U.S.C. §102.

Claims 6 and 54 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lazzarotti as applied to Claims 1 and 53 above, and further in view of Jenkins et al. (US 6,422,806). For the following reasons, the Examiner's rejection is respectfully traversed.

The proposed combination does not make obvious Claims 6 and 54. Lazzarotti fails to teach, suggest or disclose the limitations of Claims 1 and 53 as discussed above. The combination of Jenkins et al. fails to make up for the deficiencies of Lazzarotti. It is noted that Jenkins et al. is a large, industrial pallet stacking system which is unsuitable for stacking mailpieces. Further, Jenkins et al.'s pallet stacking system merely stacks a single pallet on top of another single pallet, and then moves the two stacked items out of the stacker. Jenkins et al. makes no provisions for combining multiple small stacks into a large stack. As such, Jenkins et al. does not disclose a fork lift assembly for lifting stacks of items or for combining multiple small stacks.

Jenkins et al. is not suitable for handling stacks of items, especially mailpieces, due to the difficulty in maintaining stack integrity, as recognized by Lazzarotti (see Column 2, lines 28-32). As such, one of ordinary skill in the art would not have looked to Jenkins et al. for the handling of mailpieces. It would not have been obvious to combine the teachings of these references, and there is no motivation to do so.

It should be readily apparent that any attempted combination of Lazzarotti and Jenkins et al. would result in an inoperable system. If the roller conveyor of Jenkins et al. is used in combination with Lazzarotti's accumulator to move or transfer the completed stack away from the accumulator to a tray, as the Examiner suggests, there would be no way to maintain the integrity of the stack because Lazzarotti uses the accumulator itself to maintain the integrity of the stack during stack transfer. Accordingly, the proposed combination fails to adequately teach, suggest or disclose that the means for transferring the large stack to a tray includes a plurality of driven rollers, as in Applicant's Claim 6.

Further, once two single mailpieces are stacked by Jenkins et al.'s stacker (assuming for the sake of argument it could somehow be modified to do so, and that there is some motivation to do so), they would have to be removed before the stacker would be ready to lift another mailpiece. Jenkins et al. does not teach, suggest or disclose lowering the stacker and advancing it back under the stacked pallets, to lift the stacked pallets. Accordingly, the proposed combination fails to adequately teach, suggest or disclose that a fork lift assembly extends under and holds a large stack above a small stack of mailpieces, retracts and releases the large stack onto the small stack to create a new large stack, lowers and advances back under the new large stack and raises to lift the new large stack to complete a fork lift cycle, as in Applicant's Claim 54.

For the above reasons, the proposed combination of Lazzarotti in view of Jenkins et al. fails to make obvious Applicant's Claims 6 and 54.

Claim 7 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Lazzarotti and Jenkins as applied to Claim 6 above, and further in view of Isaacs et al. (US 6,026,967). For the following reasons, the Examiner's rejection is respectfully traversed.

The proposed combination does not make obvious Claim 7. Lazzarotti in combination with Jenkins et al. fails to teach, suggest or disclose the limitations of Claims 1 and 6 as discussed above. The combination of Issacs et al. fails to make up for the deficiencies of Lazzarotti in combination with Jenkins et al. Issacs et al.'s pusher 335 pushes on the rear support paddle of an on-edge mail stack (see Column 13, lines 36-54), not on the stack itself. Nonetheless, adding Issacs et al.'s pusher to the combination of Lazzarotti and Jenkins still would result in an inoperable system. As discussed above, Lazzarotti teaches away from laterally pushing the stack out of the accumulator. Further, contrary to the Examiner's assertion, since Issacs et al. pushes the support paddle of the stack from behind, there is no teaching or motivation in the proposed combination of supporting the entire stack from a side to stabilize the stack during transfer. Accordingly, the proposed combination fails to adequately teach, suggest or disclose that the means for transferring the large stack to a tray includes, in addition to a plurality of driven rollers, a means for pushing the stack, as in Applicant's Claim 7.

For the above reasons, the proposed combination of Lazzarotti in view of Jenkins et al. and further in view of Issacs et al. fails to make obvious Applicant's Claim 7.

Claim 52 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Lazzarotti as applied to Claim 2 above, and further in view of Hendrickson et al. (US 6,241,099). For the following reasons, the Examiner's rejection is respectfully traversed.



The proposed combination does not make obvious Claim 52. Lazzarotti fails to teach, suggest or disclose the limitations of Claims 1 and 2 as discussed above. The Examiner acknowledges that Lazzarotti does not teach a means for holding the mail tray. The combination of Hendrickson et al. fails to make up for the deficiencies of Lazzarotti. Hendrickson et al. loads mailpieces directly into trays one by one. The trays 40-1, 40-2 are supported on elevator mechanism belts 48-1, 50-1 and 48-2, 50-2 respectively by appropriate teeth or lugs protruding from the belts (see Column 9, lines 28-40, and Figure 11). Once the tray is full, the operator removes the tray (see Column 12, lines 38-43). Accordingly, it is readily apparent that Hendrickson et al. fails to teach, suggest or disclose means for releasably engaging a tray including a tray latch assembly and a tray support ledge. As such, the proposed combination fails to adequately teach, suggest or disclose means for releasably engaging a tray including a tray latch assembly and a tray support ledge, as in Applicant's Claim 52.

For the above reasons, the proposed combination of Lazzarotti in view of Hendrickson et al. fails to make obvious Applicant's Claim 52.

Claim 55 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Lazzarotti and Jenkins as applied to Claim 6 above, and further in view of Mandel et al. (US 5,609,333). For the following reasons, the Examiner's rejection is respectfully traversed.

The proposed combination does not make obvious Claim 55. Lazzarotti in combination with Jenkins et al. fails to teach, suggest or disclose the limitations of Claims 1 and 6 as discussed above. The combination of Mandel et al. fails to make up for the deficiencies of Lazzarotti in combination with Jenkins et al. Mandel et al.'s stack height sensing bar is used in a printer environment to determine when a printer bin reaches a certain height as printed pages are added to the top of the stack one after another. When the certain height is reached, a controller

determines where to send additional printed sheets, i.e., to a different bin (see Column 2, lines 29-52). The stack remains in the bin and is not transferred in any way. Accordingly, Mandel et al., and thus the proposed combination, does not teach, suggest or disclose the transfer of a stack to a tray upon the stack height limit sensor being triggered, as Claim 55. Further, Mandel et al., and thus the proposed combination, does not disclose a top roller, as in Claim 55. Accordingly, the proposed combination fails to adequately teach, suggest or disclose that the means for transferring the large stack to a tray includes a plurality of driven rollers which includes a top roller connected to a pivot arm which triggers a stack height limit sensor to transfer the large stack to a tray, as in Applicants' Claim 55.

For the above reasons, the proposed combination of Lazzarotti in view of Jenkins et al. and further in view of Mandel et al. fails to make obvious Applicants' Claim 55.

In view of the above remarks, it is respectfully submitted that none of the prior art of record, either alone or in combination, fairly teaches, suggests or discloses the novel and unobvious features of Applicants' claims. Accordingly, Applicants respectfully assert that the claims as presented herein are now in condition for allowance. An early notice allowance is respectfully requested.

Any arguments of the Examiner not specifically addressed should not be deemed admitted, conceded, waived, or acquiesced by Applicants. Any additional or outstanding matters the Examiner may have are respectfully requested to be disposed of by telephoning the undersigned.

A petition for an extension of time to make this paper timely is enclosed, along with a PTO-2038 in payment of the extension fee. The Commissioner is hereby authorized to charge

any additional fees which may be required, including any additional extension of time fees necessary to make this paper timely, to Deposit Account No. 16-0657.

A postcard is enclosed evidencing receipt of the same.

Respectfully submitted,

**PATULA & ASSOCIATES, P.C.**

A handwritten signature in black ink, appearing to read "C. T. Riggs Jr.", written in a cursive style.

Charles T. Riggs Jr.

Reg. No. 37,430

Attorney for Applicants

PATULA & ASSOCIATES, P.C.  
116 S. Michigan Avenue, 14th Floor  
Chicago, Illinois 60603  
(312) 201-8220

70C41